

1999B062AU
Response to OA dated 11/1/05
Response dated 3/1/06

PATENT**REMARKS**

This reply is in response to the Office Action dated November 01, 2005. Claims 1-37 are pending in the application and stand rejected. Applicant has cancelled claims 4, 7, 19 and 22 without prejudice and amended the claims as shown above to more clearly recited aspects of the invention. Such amendments are supported in the written disclosure of the specification including the Examples, and thus do not add new matter. Applicant has also amended the specification at paragraph [0001] as suggested by the Examiner, and the specification at paragraph [0017] to clarify a clear transcriptional error. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 4-7 and 19-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention. Applicant has amended claims 7 and 22, obviating this rejection. Withdrawal of the rejection is respectfully requested.

Claims 1, 2, 4-11, 13-26, 28-30, and 32-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tracey et al. (WO 01/48033) hereafter "Tracey." The Examiner asserts that Tracey, the priority document, does not provide an adequate disclosure of the broader, alkylstyrene genus.

Applicant respectfully traverses the rejection. The alkylstyrene genus is more than adequately disclosed in Tracey. See, for example, Tracey at col. 3, ll. 20-26; and col. 3, ll. 64-66. For clarity and completeness, Applicant can amend the specification to include the subject matter from US Patent No. 5,162,445 to Powers et al. and US SIR H1475 to Newman et al., which were both incorporated by reference, if required by the Examiner. However, Applicant submits that such explicit incorporation is not necessary since a reading of Tracey makes it clear that the inventors had possession of the broader alkylstyrene genus at the time of the earlier priority date. Therefore, the broader, alkylstyrene genus is entitled to the benefit of the earlier filing date, and Tracey is not prior art under 35 U.S.C. § 102(b) for that purpose. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

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Claims 1-37 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,626,219. Applicant has included a terminal disclaimer, obviating this rejection. As such, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 1-30 and 32-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Elspass et al. (US 5,807,629) hereafter "Elspass." Applicant respectfully traverses the rejection.

Elspass does not teach, show or suggest the claimed invention. Elspass is directed at tactoidal nanocomposite materials. (Col. 2, line 9). Elspass discloses layered materials that are "swellable layered structures capable of being intercalated and having individual layer thickness... . Included are natural and synthetic minerals that have at least some cation exchange capacity such as smectic clay" (Col. 2, lines 32-39). At the very least, Elspass does not teach or suggest specific amounts of the halogenated isobutylene-co-alkylstyrene polymer or the halogen present in mol% relative to the total amount of the polymer, as required in every claim. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Furthermore, the Action states that "[I]t would have been *obvious to use* any of the noted compounds or compounds classes and blend within the scope of this patent (Elspass) as an inner tube in light of the explicit teachings that the inventive compounds have use as inner tubes" (emphasis added). As is well-known, obvious to try or use is not the standard under 35 USC § 103. See In re O'Farrell, 853 F.2d 894, 903 (Fed. Cir. 1988). Elspass provides no indication of which of the myriad of choices of blend compositions, quantities, and intra-polymer properties, i.e., halogen present in mol% relative to the total amount of the halogenated isobutylene-co-paraalkylstyrene polymer, is likely to be successful in formulating inner tubes with improved heat aging properties. Indeed, it is only in light of Applicant's specification and in hindsight that one may begin to discuss Applicants' invention. (See MPEP §§ 2141.01 III. & 2142).

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The Action goes on to state that it would have been obvious to "select an appropriate level of halogenation" and "it would have been obvious and well within the skill of the artisan to determine an appropriate blend through a balancing of the properties desired against the costs." Applicant respectfully submits that such an assertion understates the difficulties associated with producing inner tubes that are suitable for articles of commerce. Indeed, costs are but one of the many factors considered in formulating compositions for inner tubes, and costs would not provide an artisan with the guidance regarding the halogen present in mol% relative to the total amount of the halogenated isobutylene-co-alkylstyrene polymer as claimed, or the quantities to use regarding each component. Therefore, in the absence of the requisite teachings or suggestions to establish a *prima facie* case under 35 USC § 103, Applicants respectfully request that the rejection be withdrawn. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Costemalle et al. (US 5,246,778). Applicant has amended the claims as shown above, obviating this rejection. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 12, 27, 31 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tracey taken in view of Costemalle et al. (US 5,333,662) hereafter "Costemalle." Applicant has amended the claims as shown above, obviating this rejection. Furthermore, Tracey is not proper prior art for the purpose of this rejection. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Elspass taken in view of Costemalle. Applicant respectfully traverses the rejection. Since claim 31 depends from base claim 28, claim 31 is patentable at least for the same reasons presented above with regard to base claim 28. Furthermore, Elspass has been discussed and distinguished above, and Costemalle adds nothing to the deficiency of Elspass. Withdrawal of the rejection and allowance of the claims is respectfully requested.

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Claims 1-16, 19-32 and 35-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Costemalle taken in view of Elspass and the excerpted portion of the Polymeric Materials Encyclopedia.

Applicant respectfully traverses the rejection. Elspass has been discussed and distinguished above. Costemalle alone or in combination with the excerpted portion of the Polymeric Materials Encyclopedia adds nothing to the deficiency of Elspass. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction. A petition for extension of time for filing this response is attached; however, in the event that petition becomes separated from this Response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,

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